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EXAMINER

ROSSI, JESSICA

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,644

Applicant(s)

TODT, GREGORY L.

Examiner

Jessica L. Rossi

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/2/03, Prelim Amd.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-20 and 34-42 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 38-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-19, 34-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 14-19 and 34-37, drawn to a method of manufacturing a material for protecting surfaces, classified in class 156, subclass 291.

II. Claim 20, drawn to an article, classified in class 428, subclass 198.

III. Claims 38-42, drawn to a method of protecting the surface of an article during transport and storage, classified in class 53, subclass 441.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product could be made by a process where the adhesive is applied to the film or nonwoven fabric as a continuous film and then portions of the adhesive are removed to form a pattern.

3. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the method of making the material for protecting surfaces and the method of using the material for protecting surfaces are unrelated inventions requiring limitations independent of each other.

4. Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the

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product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the product could be used as a layer in a disposable article (i.e. diaper, wash cloth, etc.).

5. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Mr. Siminski on 3/1/06 a provisional election was made with traverse to prosecute the invention of Group I, claims 14-19 and 34-37. Affirmation of this election must be made by applicant in replying to this Office action. Claims 20 and 38-42 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Priority

7. The present Application claims priority to Application Serial No. 10/079,642 which has issued as US PAT 6,875,712; therefore, Applicant must amend section [0001] of the specification accordingly.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 16, 19 and 36-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding claim 16, it recites the limitation "the first and second portions" in line 4.

There is insufficient antecedent basis for this limitation in the claim. It is suggested to delete "the" from this phrase.

Regarding claim 16, it recites the limitation "the raised portions" in line 6. There is insufficient antecedent basis for this limitation in the claim. It is suggested to delete "the" from this phrase.

Regarding claim 16, it recites the limitation "the lowered portions" in line 7. There is insufficient antecedent basis for this limitation in the claim. It is suggested to delete "the" from this phrase.

Regarding claim 16, it recites the limitation "said fiber" in line 8. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change "fiber" to --film--.

Regarding claim 19, it recites the limitation "said thermoplastic film" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. It is suggested to delete "thermoplastic" before "film" and place it after "stretchable" in line 2.

Regarding claim 36, it is unclear as to how the adhesive is applied to the film when claim 34 establishes that the adhesive is applied to the nonwoven. The examiner appreciates that two embodiments are disclosed in the present specification where the adhesive can be applied to the film (Figure 1) or it can be applied to the nonwoven (Figure 10); however, the present specification does not teach applying the adhesive to both the film and nonwoven. Applicant is asked to clarify. It is suggested to change "film" to --nonwoven-- in lines 2 and 4 of claim 36.

The examiner would also like to point out that claims 17 and 34 have forced examination of the embodiment shown in Figure 10 such that any new claims directed to the embodiment

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shown in Figure 1 will be withdrawn from further consideration based on election by original presentation (see MPEP 821.03).

Regarding claim 37, it recites the limitation "said roll" in line 2. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change the dependency of claim 37 to claim 36, instead of claim 34, to establish antecedent basis for this limitation. It is also noted that claim 36 refers to a "roller" while claim 37 refers to a "roll." It is suggested to change "roller" to --roll-- in line 2 of claim 36 in order to maintain consistency throughout the claims.

Regarding claim 37, it recites the limitation "the first and second portions" in line 4. There is insufficient antecedent basis for this limitation in the claim. If claim 37 is made to depend from claim 36, then it is suggested to change "the first and second portions" to --the raised and lowered portions--.

Regarding claim 37, it is unclear how the roll engages the film in line 8 when claim 34 establishes that the adhesive is applied to the nonwoven. Applicant is asked to clarify. It is suggested to change "film" to --nonwoven-- in line 8.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 14-15 and 34-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Todt (WO 96/11804).

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With respect to claim 14, Todt teaches a method of manufacturing a material for protecting surfaces comprising the steps of providing a shrinkable film 12 having a pre-determined shrink response when heat is applied thereto and a nonwoven fabric 14, applying an adhesive to at least one of said film or nonwoven fabric in a predetermined pattern defining first areas bearing said adhesive in said pattern and second areas substantially larger than the first areas extending between the pattern of said first areas bearing said adhesive, and adhering the nonwoven fabric and film together by said adhesive (Figure 1; abstract; p. 4, lines 17-22; p. 5, lines 2-18; p. 6, lines 12-25).

Regarding claim 15, Todt teaches the adhesive being a hot melt adhesive (p. 2, lines 16-18) and the nonwoven fabric being adhered to said film by pressing the film and nonwoven fabric together with limited pressure (p. 6, lines 17-20).

With respect to claim 34, all the limitations were addressed above with respect to claim 14 except applying the adhesive to the nonwoven. Todt teaches such (p. 5, lines 1-4; p. 6, lines 12-15).

Regarding claim 35, Todt teaches the adhesive being a pressure responsive adhesive and the nonwoven being adhered to the film by pressing the film and nonwoven together (p. 2, lines 16-18; p. 6, lines 12-20).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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13. Claims 16-19 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todt as applied to claims 14 and 34 above and further in view of the collective teachings of Ankuda et al. (US 6638605) and Woods et al. (US Re 36601).

Regarding claims 16 and 36-37, it is unclear as to whether the adhesive applicator of Todt satisfies the claimed limitations. One reading Todt as a whole would have readily appreciated that the reference is not concerned with a particular adhesive applicator. Therefore, it would have been obvious to one of ordinary skill in the art to use a gravure roll and doctor blade, as set forth in the present claims, because such is a well known and conventional applicator for applying adhesive to a substrate in a pattern, as taught by the collective teachings of Ankuda (Figures 6-7; column 10, lines 54-60; column 11, lines 24-32 and 43-44) and Woods (Figure 5; column 5, lines 39-56), where the gravure roll allows for the application of adhesive in a desired pattern and the doctor blade removes excess adhesive from the roll to control the amount of adhesive applied to the substrate.

Regarding claim 17, Todt teaches applying the adhesive to the nonwoven (p. 5, lines 1-4; p. 6, lines 12-15).

Regarding claim 18, Todt teaches the film and nowoven being intermittently bonded (p. 5, lines 1-18).

Regarding claim 19, Todt teaches the film being a shrinkable stretchable thermoplastic film (p. 4, lines 17-26).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JESSICA ROSSI
PRIMARY EXAMINER

Jessica Rossi